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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,428	02/26/2002	Michael S.H Chu	81747	6735

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EXAMINER

DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

6

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,428

Applicant(s)

CHU ET AL.

Examiner

Matthew F DeSanto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 4,7,8,11,12,19 and 23-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,9,10,13-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2, 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, and Species A in Paper No. 5 is acknowledged.
2. Claims 4,7,8,11,12,19 and 23-38 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention and Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
4. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. With regards to claim 15, the term "inverted" makes the claim unclear because the examiner does not understand how the medical catheter is "inverted." The examiner used the broad definition of "inverted" (based on Merriam-Webster Online Dictionary) and concluded that the medical catheter would be "turned inside out" and this did not make sense to the examiner. The examiner suggests the use of a different term to describe the characteristic and interact between the medical catheter and the sleeve or further clarification on this matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 5, 6, 9, 10, 15-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Goelz (USPN 5,527,280).

Goelz has a medical catheter (10), an inner sleeve (32), a cap (38), a fitting (40), an external bolster or base (14), a sleeve (27 [with regards to claim 15]) and a plug (29), wherein the inner sleeve has an open proximal end, an open distal end and a longitudinal bore extending from said open proximal end to said open distal end wherein the fitting has an open proximal end and an open distal end, said open distal end of said fitting being coupled to said proximal end of said inner sleeve in such a way as to permit materials to pass between said fitting and said inner sleeve (See Figure 2, 4, 6 and entire reference).

With regards to claim 15 wherein the medical catheter further comprising a body, said body having a base and a sleeve, said base having a transverse bore, said sleeve extending upwardly from said base and having a longitudinal bore, said longitudinal bore of said sleeve being aligned with said transverse bore of said base, said proximal

end of said medical catheter being inserted up through said transverse bore of said base and said longitudinal bore of said sleeve and then inverted over the top of said sleeve. (See Figure 2, 4, 6 and entire reference)

8. Claims 1-3, 5, 6, 9, 10, 15, 16, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by McNeely et al. (USPN 5,458,583).

McNeely et al. has a medical catheter (13), an inner sleeve (30), a fitting, an external bolster or base (25), a sleeve (22 [with regards to claim 15]), and wherein the inner sleeve has an open proximal end, an open distal end and a longitudinal bore extending from said open proximal end to said open distal end wherein the fitting has an open proximal end and an open distal end, said open distal end of said fitting being coupled to said proximal end of said inner sleeve in such a way as to permit materials to pass between said fitting and said inner sleeve (See Figure 3, 6, 9 and entire reference).

With regards to claim 15 wherein the medical catheter further comprising a body, said body having a base and a sleeve, said base having a transverse bore, said sleeve extending upwardly from said base and having a longitudinal bore, said longitudinal bore of said sleeve being aligned with said transverse bore of said base, said proximal end of said medical catheter being inserted up through said transverse bore of said base and said longitudinal bore of said sleeve and then inverted over the top of said sleeve. (See Figure 3, 6, 9 and entire reference)

9. Claims 1, 2, 3, 5, 6, 9, 10, 13, 14, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Santomieri (USPN 3,938,530).

Santomieri discloses a medical catheter (1), an inner sleeve (6, 14), a fitting (16), an external bolster or base and a plug (17), wherein the inner sleeve has an open proximal end, an open distal end and a longitudinal bore extending from said open proximal end to said open distal end wherein the fitting has an open proximal end and an open distal end, said open distal end of said fitting being coupled to said proximal end of said inner sleeve in such a way as to permit materials to pass between said fitting and said inner sleeve (See Figures 1-3 and entire reference).

10. Claims 1, 2, 3, 5, 6, 9, 10, 15-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Adair (USPN 3,946,741).

Adair has a medical catheter (12), an inner sleeve (14), a cap (60), a fitting (52), an external bolster or base (54), and a sleeve (62) ([with regards to claim 15]), wherein the inner sleeve has an open proximal end, an open distal end and a longitudinal bore extending from said open proximal end to said open distal end wherein the fitting has an open proximal end and an open distal end, said open distal end of said fitting being coupled to said proximal end of said inner sleeve in such a way as to permit materials to pass between said fitting and said inner sleeve (See Figure 2 and entire reference).

With regards to claim 15 wherein the medical catheter further comprising a body, said body having a base and a sleeve, said base having a transverse bore, said sleeve extending upwardly from said base and having a longitudinal bore, said longitudinal bore of said sleeve being aligned with said transverse bore of said base, said proximal end of said medical catheter being inserted up through said transverse bore of said

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base and said longitudinal bore of said sleeve and then inverted over the top of said sleeve. (See Figure 2 and entire reference)

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-3, 5, 6, 9, 10, 13-18, and 20-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. Chu et al. (USPN 6,666,853). Although the conflicting claims are not identical, they are not patentably distinct from each other because they both contain the medical catheter, the inner sleeve, the cap, the clamp, the body, the fitting, the plug and the sleeve.

Allowable Subject Matter

13. Claims 21 and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action, as well as the double patenting rejection and to include all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew DeSanto
Art Unit 3763
April 2, 2004


LOAN H. THANH
PRIMARY EXAMINER